

REMARKS

Claims 1, 2, 4, 5, 7 and 9 are pending in this application. By this Amendment, claim 1 is amended. The amendments add no new matter as they are supported by at least the claims as originally filed. Claim 8 is canceled without prejudice to, or disclaimer of, the subject matter recited in that claim. Reconsideration of the application is respectfully requested.

The Office Action, in paragraph 2, rejects claims 1, 2, 4, 5, 7 and 9 under 35 U.S.C. §103(a) over Japanese Patent No. JP 02-A-002324627 to Fukushima et al. (hereinafter "Fukushima") in view of U.S. Patent No. 5,304,067 to Inaba et al. (hereinafter "Inaba"). The Office Action, in paragraph 3, rejects claim 8 under 35 U.S.C. §103(a) over Fukushima in view of Inaba, as applied to claim 1, and further in view of U.S. Patent No. 6,609,934 to Chen et al. (hereinafter "Chen"). These rejections are respectfully traversed.

Claim 1 is amended to incorporate the subject matter of now canceled claim 8.

At the outset Applicant notes that, in response to Applicant's arguments provided in the January 10, 2005 Amendment, the Office Action explains in paragraph 4 that the rejection of the claims over the combination of Fukushima and Inaba "has been modified with a better defining motivational statement." The Office Action, in paragraph 2, now states that it would have been obvious to one of ordinary skill in the art to use the elastic material covering member of Inaba on a device of Fukushima "in order to provide protection of the device."

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection under 35 U.S.C. §103(a) over the combination of Fukushima and Inaba is improper in view of

at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the references for one of ordinary skill to combine the references.

Further, the Office Action, in paragraph 3, recognizes that the combination of Fukushima and Inaba does not disclose a slit formed on the covering member from the opening end of the small-diameter portion. Rather, the Office Action relies on Chen in, for example, Fig. 3 as allegedly disclosing slits (unnumbered between tentacles 404), which the Office Action considers to correspond to a slit formed on the covering member from the opening end of the small-diameter portion, as is recited, among other features, in independent claim 1 (incorporating the subject matter previously recited in now canceled claim 8).

The electromagnetic shielding component depicted in Fig. 3 of Chen is a tube shaped shield shell made of thin sheet metal, the walls of which "comprise a plurality of strip-like tentacles 404 at their rear ends that extend toward the cable 30." It is the gaps between these strip-like tentacles that the Office Action considers to correspond to a slit formed on the covering member, concluding that it would have been obvious to one of ordinary skill in the art to use the slit on the covering member of Chen on the device of Fukushima "in order to embrace the periphery of the cable." Again here, with reference to MPEP §2143.01 the Office Action lacks the required specific evidence of a teaching, suggesting or motivation in the references for one of ordinary skill in the art to combine the reference to render obvious this feature.

Further, to the extent that these references are arguably combinable, a conclusion which the Applicant does not concede for at least the reason stated above, the shield shell taught by Chen is made of a thin metal sheet and is not formed of an elastic material. Given the teachings of Fukushima and Inaba, particularly in light of the conclusion of the Office Action that one of ordinary skill in the art would have been motivated to combine these

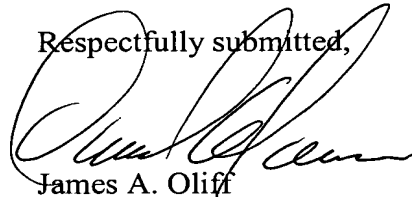
references by using the elastic material covering member of Inaba on the device of Fukushima to provide protection for the device, one of ordinary skill would then not have been motivated further to combine a thin sheet metal shield shell such as that disclosed in Chen. In other words, it is internally inconsistent for the Office Action, on the one hand, to assert that it would have been obvious to modify the device of Fukushima with the elastic material covering member of Inaba and then to further modify that combination by incorporating the thin sheet metal shield shell of Chen. Also, the slits in Chen are not provided for elastic deformation such as that discussed in the disclosure of this application (see *e.g.*, page 15, line 20 - page 17, line 4).

For at least these reasons, the combination of Fukushima, Inaba and Chen cannot reasonably be considered to have suggested the combination of all of the features recited in at least independent claim 1. Further, claims 2, 4, 5, 7 and 9 are also allowable over the combination of the applied references for at least the respective dependences of these claims, directly or indirectly, on independent claim 1, as well as for separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 4, 5, 7 and 9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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